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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,892	12/09/2003	Warren Douglas Sheffield	337348055US1	4677
25096	7590	07/17/2007		
PERKINS COIE LLP			EXAMINER	
PATENT-SEA			REIDEL, JESSICA L	
P.O. BOX 1247				
SEATTLE, WA 98111-1247			ART UNIT	PAPER NUMBER
			3766	
			MAIL DATE	DELIVERY MODE
			07/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/731,892	Applicant(s) SHEFFIELD ET AL.	
	Examiner Jessica L. Reidel	Art Unit 3766	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 74 and 82.
- Claim(s) objected to: 13 and 48.
- Claim(s) rejected: 1,4-7,9-12,14-23,25-27,32-43,45-57,61-70,72,73,75,76,78-81 and 83-86.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Kennedy J. Schaetzle/
 Primary Examiner, AU 3766
 July 13, 2007

Continuation of 3. NOTE: The Examiner has sufficiently considered Applicant's arguments, however, they are not persuasive and they do not place the application in condition for allowance. Applicant argues throughout the Remarks that Schiff, not the combination of references, expressly teaches away from the elements of the claims, however in the Final Rejection of May 4, 2007 Claims 19-20, 22-23, 25-27, 32, 35-39, 78-79 and 86 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff in view of Firlik '419 and Firlik '201 and Claims 1-7, 9-12, 14-18, 21, 40-43, 45-47, 49-55, 61-70, 72-73, 75-76, 80-81 and 83-85 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff in view of Firlik '419 and Firlik '201, and in further view of McDermott and Binder. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Examiner agrees that the stimulation site of Schiff is selected such that electrodes are embedded or placed at a deep brain location, preferably on/near/within the intralaminar nuclei or on/near/within a portion of other thalamic nuclei and as discussed at pages 6-8 of the Final Rejection, it was noted that Schiff discloses the claimed invention except it is not specified that the stimulation site be selected or located proximate the dura mater, and outside a cortical surface of the patient's brain. The Examiner further discussed, however, that Firlik '419 and Firlik '201 both expressly disclose and teach that it is well known in the art of electrical brain stimulation to chose a stimulation site for electrode implantation that is proximate the dura mater and outside a cortical surface of a patient's brain in order to provide a less invasive means for effecting not only cortical stimulation, but deep brain stimulation as well, in order to effectively treat a patient having impaired cognitive function.

In response to Applicant's argument that the stimulation of Firlik '419 and Firlik '201 "is applied to the cortex", the Examiner respectfully disagrees. The stimulation of Firlik '419 and Firlik '201 is selectively applied to not only the cortex, but to other regions of the brain, including the deep brain regions. Both Firlik '419 and Firlik '201 expressly disclose that the stimulation site is located such that an electrical field is generated at that site to selectively stimulate cortical and/or deep brain regions (see Firlik '419 page 4, paragraph 61 and Firlik '201 page 4, paragraph 63). Both references also expressly disclose that by locating the stimulation site/implantation site for stimulation electrodes proximate the dura mater and outside a cortical surface of the brain, the procedure for treating impaired cognitive function is sufficiently improved and less invasive than those methods of Schiff and other prior art methods of providing electrical brain stimulation for treating impaired cognitive function (see Firlik '419 pages 1-3, paragraphs 6-18 and Firlik '201 pages 1-3, paragraphs 6-18) since the electrical stimulation may be selectively applied at precise stimulation sites throughout/within cortical and/or deep brain locations of the brain (see Firlik '419 pages 8-12, paragraphs 87-121 and Firlik '201 pages 9-12, paragraphs 98-127). It would have been obvious to one having ordinary skill in the art at the time the invention was to modify the method of Schiff such that the stimulation site is located proximate the dura mater, and outside a cortical surface of the brain, since such a modification would provide a means for selectively effecting deep brain stimulation without inducing serious complications from a highly invasive procedure as taught by Firlik '419 and Firlik '201.

It is to the Examiner's best understanding that throughout pages 21-24 of the Remarks, Applicant has only provided arguments that Schiff expressly teaches away from Applicant's invention as defined by the claims. As discussed above, these arguments were not found to be persuasive. In response to Applicant's argument that the combination(s) of references as applied in the Final Rejection teaches away from elements in the claims, the Examiner respectfully disagrees and notes that Applicant has not provided sufficient reasoning and/or evidence to support such argument(s). The Examiner acknowledges that it is improper to combine references where the references teach away from their combination (see *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983), however the suggestion to modify the method of Schiff such that the stimulation site is located proximate the dura mater, and outside a cortical surface of the brain was expressly provided by both Firlik '419 and Firlik '201, as previously discussed. The proposed modification does not render the prior art unsatisfactory for its intended purpose or change its principle of operation (i.e. effecting deep brain electrical stimulation for the treatment of impaired cognitive function). See MPEP 2143.01.

/Kennedy J. Schaetzle/
Primary Examiner, AU 3766
July 13, 2007